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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,888	04/06/2001	Hisashi Hotta	003510-091	3377

7590

02/25/2004

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,888

Applicant(s)

HOTTA, HISASHI

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2003 has been entered.
2. Claim 1 is allowed.
3. The drawings were received on December 1, 2003. These drawings are acceptable.
4. Applicants have amended claim 2 such that claims 2-21 are broader in scope than previously examined. The removal of a limitation to contact angle with respect to instant (ii) broadens the scope of plates now claimed.
5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 2-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants in claim 2 under (ii) now claim a vacancy ratio from 20% to 70%, and micropores physically exposed on the surface of the anodic oxidation coating having diameter of not more than 15nm, wherein these values are for the aluminum substrate which has an anodic oxidation coating disposed therein wherein anodic oxidation coating has these properties before

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the recording layer is provided thereon to form the claimed planographic printing plate. This is broader condition than that originally disclosed in the application and claims. Applicants deleted the "and a contact angle of a non-image area of the anodic oxidation coating after a developing process of not more than 20° which as also been required of the (ii) condition. Applicants have not specifically pointed out support for the broader more generic plate now being claimed.

Under certain circumstances, omission of a limitation can raise an issue regarding whether the inventor had possession of a broader, more generic invention. See, e.g., *PIN/NIP, Inc. V. Platte Chem. Co.*, 304 F.3d 1235, 1248 64 USPQ2d 1344, 1353 (Fed. Cir. 2002), *Gentry Allery, Inc V. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir 1998). *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962). In the paragraph bridging pages 7-8 of the original specification, applicants made clear that with two separate plates satisfied their present invention. With respect to (ii), the vacancy ratio limitation, the diameter of the micropore limitation and the contact angle limitation were all required to meet their requirements for their invention. Table 3 on page 49 shows in Comparative Example ii-3 a plate which meets the requirements with respect to vacancy ratio and diameter of the micropore but has a contact angle not within the required "not more than 20° ". On page 51 of the original specification, applicants reference Comparative examples ii-3 as having inferior anti-staining properties and states in the last full paragraph, "And even though vacancy ratio of the formed coating is in the scope of the present invention in the case that diameter of micropore and contact angle is out of the range of the present invention as in Comparative examples ii-2 and ii-3, anti-staining properties are inferior." Thus, the original specification and claims do not support the generic plate of (ii) condition now

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claimed. Workers of ordinary skill in the art would not have recognized the plate without the contact angle limitation as being part of the invention disclosed.

7. The examiner notes that the other amendments to claim 21 are supported with original disclosure as set forth by applicants in their amendment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff, can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cynthia Hamilton
Primary Examiner
Art Unit 1752

February 19, 2004

CYNTHIA HAMILTON
PRIMARY EXAMINER

CYNTHIA HAMILTON
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